



501.34466CC4/219500630US5

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant : Takayuki TAMURA *et al.*  
Serial No. : 10/748,156  
Filed : 31 December 2003  
For : EXTERNAL STORAGE DEVICE AND MEMORY  
ACCESS CONTROL METHOD THEREOF  
Art Unit : 2133  
Examiner : P.M. Chung  
Conf. No. : 6972

**INFORMATION DISCLOSURE STATEMENT UNDER 37 CFR §1.97(c)**

**Mail Stop Amendment**

Commissioner for Patents  
POB 1450  
Alexandria, Virginia 22313-1450

26 November 2004

Sir:

In the matter of the above-identified application, Applicant hereby submits the attached information for consideration by the Office under 37 C.F.R. §§1.97 and 1.98, as listed on the accompanying Form PTO-1449.

This case is related to copending Application No. 10/639,808 filed on 30 July 2003, pending, which is a continuation of Application No. 10/373,872 filed on 27 February 2003, pending, which is a continuation of Application No. 10/105,275 filed on 26 March 2002; which is a continuation of Application No. 09/886,133 filed on 22 June 2001 and issued as US 6,388,920 B1, which is a continuation of Application No. 09/824,778 filed on 4 April 2001 and issued as US 6,317,371 B1, which is a continuation of Application No. 09/477,665 filed on 5 January 2000 and issued as US 6,236,601 B1, which is a continuation of Application No. 09/125,547

filed on 23 December 1998 and issued as US 6,031,758 A, which is an application under 35 USC §371 of International Application PCT/JP96/03501 filed 29 November 1996. All of the information listed on the attached Form PTO-1449 was previously cited by or submitted to the Office in the prior applications.

This Information Disclosure Statement is being filed after the mailing of a first USPTO Communication treating this case on the merits, but before the mailing of any Communication which closes action on the merits. Filed concurrently herewith is Form PTO-2038 including payment of the requisite filing fee under 37 CFR §1.97(c). To whatever other extent is actually necessary, please charge any deficiency in fees to ATSK Deposit Account No. 01-2135 (as Case No. 501.34466CC4).

Respectfully submitted,



---

Paul J. Skwierawski  
Registration No. 32,173  
ANTONELLI, TERRY, STOUT & KRAUS, LLP  
1300 North Seventeenth Street, Suite 1800  
Arlington, Virginia 22209-3801, USA  
Telephone 703-312-6600  
Facsimile 703-312-6666

ATTACHMENTS:

Five (5) US Patents  
One (1) US Published Application  
Form PTO-1449  
Form PTO-2038 (Fee Code 1806)

Form PTO-1449	U.S. DEPARTMENT OF COMMERCE PATENT AND TRADEMARK OFFICE	ATTY. DKT. NO. 501.34466CC4	SERIAL NO. 10/748,156
INFORMATION DISCLOSURE STATEMENT BY APPLICANT  (Use several sheets if necessary)		APPLICANT	
		FILING DATE 31 December 2003	GROUP 2133

*O I P E*  
NOV 26 2004  
U.S. TRADEMARK OFFICE

## U.S. PATENT DOCUMENTS

Examiner Initial	Document Number	Date	Name	Class	Subclass	Filing Date
AA	5,859,804	01/1999	Hedberg <i>et al.</i>			
AB	6,058,047	05/2000	Kikuchi			
AC	5,920,515	07/1999	Shaik <i>et al.</i>			
AD	6,542,405	04/2003	Katayama <i>et al.</i>			
AE	6,426,893	07/2003	Conley <i>et al.</i>			
AF	2004-0022249-A1	05/2004	Katayama <i>et al.</i>			
AG						
AH						
AI						

## FOREIGN PATENT DOCUMENTS

Examiner Initial	Document Number	Date	Country	Class	Subclass	Translation/Abstract	
						Yes	No
AJ							
AK							
AL							
AM							
AN							
AO							
AP							
AQ							
AR							
AS							
AT							
AU							
AV							

## OTHER DOCUMENTS (Including Author, Title, Date, Pertinent Pages, Etc.)

AW	
AX	
AY	

Examiner	Date Considered
----------	-----------------

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

**TERMINAL DISCLAIMER TO OBVIATE A DOUBLE PATENTING  
REJECTION OVER A "PRIOR" PATENT**Docket Number (Optional)  
**501.34466CC4**

Name Application of: Takayuki TAMURA et al.

Application No.: 10/748,156

Filed: 31 December 2003

For: EXTERNAL STORAGE DEVICE AND MEMORY ACCESS CONTROL METHOD THEREOF

The owner\*, HITACHI, LTD., of 100 percent interest in the instant application hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application which would extend beyond the expiration date of the full statutory term prior patent No US 6,701,471 B2 as the term of said prior patent is defined in 35 U.S.C. 154 and 173, and as the term of said prior patent is presently shortened by any terminal disclaimer. The owner hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and the prior patent are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.

In making the above disclaimer, the owner does not disclaim the terminal part of the term of any patent granted on the instant application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. 154 and 173 of the prior patent, "as the term of said prior patent is presently shortened by any terminal disclaimer," in the event that said prior patent later:

- expires for failure to pay a maintenance fee;
- is held unenforceable;
- is found invalid by a court of competent jurisdiction;
- is statutorily disclaimed in whole or terminally disclaimed under 37 CFR 1.321;
- has all claims canceled by a reexamination certificate;
- is reissued; or
- is in any manner terminated prior to the expiration of its full statutory term as presently shortened by any terminal disclaimer.

Check either box 1 or 2 below, if appropriate.

1.  For submissions on behalf of a business/organization (e.g., corporation, partnership, university, government agency, etc.), the undersigned is empowered to act on behalf of the business/organization.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

2.  The undersigned is an attorney or agent of record. Reg. No. 22,466



Signature

26 November 2004

Date

Melvin Kraus

Typed or printed name

703-312-6600

Telephone Number

- Terminal disclaimer fee under 37 CFR 1.20(d) included.

**WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.**

\*Statement under 37 CFR 3.73(b) is required if terminal disclaimer is signed by the assignee (owner).  
Form PTO/SB/96 may be used for making this certification. See MPEP § 324.

This collection of information is required by 37 CFR 1.321. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

11/29/2004 FMETEKI1 00000048 10748156

02 FC:1814

110.00 OP